

03630.000307



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
: Examiner: L. Nash
DON HIDEYASU MATSUBAYASHI, et al.)
: Group Art Unit: 2153
Application No.: 09/919,729)
:
Filed: August 1, 2001)
:
For: FLEXIBLE SECURE NETWORK)
DATA TRANSFER AND : April 27, 2007
MESSAGING)

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REMARKS

Sir:

These remarks are being filed concurrently with a Request for Continued Examination (RCE) in the above-identified application.

Applicants again thank the Examiner for the courtesies and thoughtful treatment afforded during two telephone interviews conducted in March, 2007, and for the Examiner's agreement that the current rejection would be withdrawn if the claims were amended so as to specify functionality of the claimed cable head end.

The purpose of these Remarks is to comment on the soundness of the obviousness rejections entered thus far.

The rejections are based on combinations of up to six different cited references, and in fact there is a seventh un-cited reference: U.S. Patent 6,389,462 to

Cohen (see pages 5, 8 and 12 of the Final Rejection). Applicants respectfully contend that an insufficient rationale has been articulated as to why it would have been obvious to combine these seven references in the manner proposed by the Office Action. Such a rationale must be an art-based rationale, which means that the rationale must be found in the art itself. See MPEP § 2141, *et seq.* That is, unless the articulated rationale is based on disclosure and/or suggestion from the art itself, then there is danger of injecting impermissible hindsight into the analysis of obviousness.

Here, it is respectfully submitted that the articulated rationale for combining references is deficient since it is based entirely on a *post-hoc* rationale, rather than art-based evidence. The final Office Action cites to various portions of the applied art, but when the cited portions are read, they do not support the conclusions that are drawn from them. For example, page 5 of the Office Action provides the following rationale for combining Williams with an already-deficient combination of Metz and Hu:

“One of ordinary skill in the art would have been motivated to implement this in the method as disclosed by Metz and Hu, so as to maintain independent yet concurrent active process for multiple users and reducing the cost associated with integrating the capability in the set-top-box (i.e. no additional hardware or software needed for the set-top-box; Williams column 4, lines 1-23).” (Final Office Action dated November 30, 2006, at pages 5-6).

When the cited portions of column 4 in Williams are read, they refer to a reduction in costs in a set top box (STB). This disclosure is a far cry, however, from a suggestion as to how such costs might be reduced, other than the specific cost-reduction proposals made by Williams himself. Such cost-reduction proposals are entirely different from those of the present invention. Thus, although Williams might express a laudable

goal of cost-reduction, there is still nothing in Williams that provides any guidance as to how these goals might be achieved, much less that they might be achieved in the manner set out in the invention.

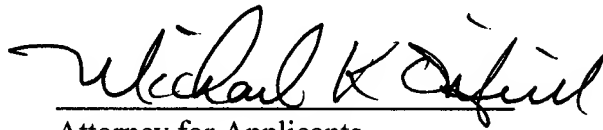
It is Applicants' position that all of the rationales in the Office Action, as to why it would have been obvious to make combinations, suffer from the same deficiencies. Specifically, the Office Action has identified generalized goals and/or objectives, such as the goal of cost-reduction in Williams. These goals are only generalized, however, and provide no specific guidance as to how such goals might be achieved, and certainly provide no guidance that these goals might be achieved in the manner set out in the invention herein.

Put another way, the rationale in the Office Action proves too much. If cost-reduction alone were sufficient motivation for modification of a reference, then all inventions would be obvious. Certainly, this is not the law. Rather, obviousness must be evaluated at the time of the invention, giving due consideration to the level of ordinary skill in the art.

It is respectfully requested for the Examiner to re-evaluate her rationale for modifications and combinations of references, and to withdraw all obviousness rejections.

Applicants' undersigned attorney may be reached in our Costa Mesa,
California office by telephone at (714) 540-8700. All correspondence should be directed to
our address given below.

Respectfully submitted,

A handwritten signature in black ink, reading "Michael K. O'Neill", written over a horizontal line.

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